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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attorney Docket No.
VIGN1200-1

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as Express Mail to Addressee (Label No. EV734540247US) in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on **August 11, 2006**

Onita Cannon

Application No.	Filed:
09/965,914	**09/28/2001**
First Named Inventor: **Conleth S. O'Connell**	
Art Unit **2141**	Examiner **Luu, Le Hien**

Applicant requests review of the rejection of Claims 1-61 (rejected at least twice) in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor
- ☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ **Attorney or agent of record. Registration No. 48,828**
- ☐ Attorney or agent acting under 37 CFR 1.34 Registration No. _____

Signature

John L. Adair
Typed or Printed Name

512-637-9223
Telephone Number

8/11/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below*.

☐ *Total of _____ forms are submitted.

Remarks

In an Office Action dated April 11, 2006 (the "April 11 Office Action"), the Examiner rejected Claims 1-61 under 35 U.S.C. §103(a) as being obvious in light of the combination of by U.S. Patent No. 6,591,266 issued to Li et al. ("Li") and United States Patent No. 6,697,849 issued to Carlson ("Carlson'). The Examiner had previously rejected the same claims over the same art in an Office Action dated March 25, 2005 (the "March 25 Office Action") and an Office Action dated November 23, 2005 (the "November 23 Office Action").

The effective date of a United States Patent is the earlier of its publication date or that date that it is effective as a reference under 35 U.S.C. 102(e). *See* 37 C.F.R. 1.131. Li issued on July 8, 2003, after the present application was filed and therefore can only be considered under 35 U.S.C. 102(e). According to 35 U.S.C. 102(e) the invention must be described in "an application for patent or . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." Li claims priority to United States Provisional Patent Application No. 60/218,418 having a filing date of July 14, 2000. Therefore, the earliest effective filing date of Li is July 14, 2000. To properly qualify as prior art under 35 U.S.C. 102(e), the July 14, 2000 effective filing date of Li must be earlier than the date of invention of the present invention. The Applicant has submitted a Declaration Under 37 C.F.R. 1.131 (the "Declaration") averring to the fact that the present invention was conceived prior to July 14, 2000, yet the Examiner has failed to consider the merits of the Declaration.

On August 25, 2005, Applicant submitted a reply to the March 25, 2005 Office Action (the "August 25 Reply"). Attached to the August 25 Reply as Exhibit 1 was the Declaration, further including an email drafted by Mr. O'Connell as Exhibit A and a software specification distributed by the inventors that described in the claimed invention as Exhibit B. Mr. O'Connell averred to the following facts: the claimed invention was conceived at least as early as January 7, 2000 (*see* August 25 Reply, Exhibit 1, Declaration, page 1, ¶2); the email attached as Exhibit A to the declaration was drafted on January 7, 2000 (*see* August 25 Reply, Exhibit 1, Declaration, page 1, ¶3); the specification attached to Exhibit B of the declaration was drawn up prior to January 7, 2000 (*see* August 25 Reply, Exhibit 1, Declaration, page 1 ¶4); and the specification attached as Exhibit B demonstrates conception of the invention as described and claimed in the patent application, (*see* August 25 Reply, Exhibit 1, Declaration, page 1

¶5). Mr. O'Connell acknowledged that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. (*see* August 25 Reply, Exhibit 1, Declaration, page 1 ¶6).

In the November 23 Office Action, the Examiner stated that "Exhibits A and B do not explicitly prove, demonstrate, nor clearly show in details how the claimed invention can constructed using information from the email and outline in Exhibits A and B." *See* November 23 Office Action, page 2. The Examiner then went on to question the truth of Mr. O'Connell's statements that the email was sent on January 7, 2000, stating "the validity of the email in Exhibit A is questionable because Examiner notes that [sic] time stamp and subject header of the email in Exhibit A were missing."

Applicant again submitted the Declaration in a Reply dated February 23, 2005 (the "February 23 Reply"). In the April 11, 2006 Office Action, the Examiner again rejected the Declaration stating:

> The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Li et al. reference . . . conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended . . . Exhibits A and B do not explicitly prove, demonstrate, nor clearly show in details how the claimed invention can be constructed using information from the email and outline in the Exhibits A and B . . . The affidavit or declaration an exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular data. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice 'amounts to mere pleading, unsupported by proof or showing of facts' and, thus does not satisfy the requirements of 37 C.F.R. 1.131 (b). *See*, April 11 Office Action, page 2 [Emphasis Added].

The Examiner's rejection of the declaration was improper and the Examiner's baseless questioning of the veracity of Mr. O'Connell's statements regarding the date of the email—statements made in a legal document in which Mr. O'Connell acknowledged

that willful false statements were punishable by fine or imprisonment—was inappropriate.

First addressing the Examiner's inappropriate questioning of Mr. O'Connell's averments, Applicant points to MPEP 715.07, which clearly states "if the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration." Thus, Mr. O'Connell's averments in the Declaration establish that the email was sent on January 7, 2000 are sufficient to establish that the email was sent January 7, 2000 and there is no basis to question the veracity of this statement.

Turning now to the propriety of the Examiner's rejection, it appears that the Examiner is seeking unnecessary corroboration for the inventor's statements. Moreover, the Examiner is constantly looking for evidence as to the construction of the invention (i.e., reduction to practice), not the conception of the invention. Indeed, the Examiner even quotes passages of the MPEP that are drawn to evidence regarding reduction to practice, not conception.

Applicant notes, that unlike interference practice, "averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration; an inventor may stand on his or her own affidavit if he or she so elects." *See* MPEP 715.07 (emphasis added). In this case, Mr. O'Connell has averred to the fact that he conceived the claimed invention at least as early as January 7, 2000 and that the conception of the invention is demonstrated in Exhibit B of his declaration. *See* August 25 Reply, Exhibit 1, page 1, ¶2, 4, 5. In this case, Mr. O'Connell has provided more than necessary as he has provided corroborating evidence, in the form of Exhibit B of the Declaration, demonstrating conception of this invention.

Moreover, "in reviewing a 37 C.F.R. 1.131 affidavit or declaration, the examiner must consider all the evidence presented in its entirety." *See* MPEP 715.07 (emphasis added). In addition to Mr. O'Connell's averments, the evidence as a whole shows that the inventors had "more than a vague idea of how to solve a problem." The email of Exhibit A of the Declaration evidences that the inventors distributed the specification of Exhibit B for purposes of implementation, demonstrating that the inventors had much more than "a mere vague idea of how to solve the problem . . ." Specifically, the email, in discussing the specification of Exhibit B of the Declaration, states, "I'm hoping it is clear enough. If not I'm available to talk about. If any other issues come up as you go through the implementation . . . ." *See* August 25 Reply, Exhibit 1, Declaration, Exhibit A

(referring to Exhibit B, which Mr. O'Connell avers provides a detailed specification showing conception of the invention).

The evidence as a whole, including the averments of Mr. O'Connell in the Declaration and the Exhibits attached to the Declaration show that, on January 7, 2000, the inventors had more than a "vague idea of how to solve the problem" but had at least reached the point of distributing the specification for purposes of implementation. Thus, the Declaration and attached exhibits clearly demonstrate conception at least as early as January 7, 2000. The invention was constructively reduced to practice in United States Provisional Patent Application No. 60/236,618 filed September 29, 2000. Applicant therefore submits that the Examiner was incorrect in maintaining the rejections of Claims 1-61 as the present invention was invented prior to the filing of Li.